IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s):	Klaus Maler
Appl. No.:	09/509,408
Conf. No.:	3860
Filed:	March 27, 2000
Title:	COMMUNICATION TERMINAL EQUIPMENT FOR WIRELESS COMMUNICATION WITH TRANSMISSION/RECEPTION BASE STATIONS OF DIFFERENT COMMUNICATION SYSTEMS
Art Unit:	2686
Examiner:	Mehrpour, N.
Docket No.:	112740-421

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S APPEAL BRIEF

Sir:

Appellant submits this Appeal Brief in support of the Notice of Appeal filed on December 15, 2003. This Appeal is taken from the Final Rejection dated July 14, 2003.

I. REAL PARTY IN INTEREST

Siemens Aktiengesellschaft is the real party in interest of the above-identified patent application by virtue of an assignment executed on September 18, 1998 and recorded in the United States Patent and Trademark Office on Reel 010799, Frame 0107.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge there are no pending appeals or interferences that will directly affect, have bearing on, or that will be directly affected by the Board's decision with respect to the above-identified appeal.

III. STATUS OF CLAIMS

Claims 7-12 are pending in the application. A copy of the present claims is attached in the Appendix. Presently, claims 7-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,754,542 to *Ault* in view of U.S. Patent No. 5,995,828 to

Nishida . A copy of the final Office Action (Paper No. 13) and the *Ault* and *Nishida* references on which the rejection was based are included in the Supplemental Appendix as Exhibits A, B and C, respectively.

IV. STATUS OF AMENDMENTS

The last amendment considered by the Examiner was filed on April 3, 2003.

V. SUMMARY OF INVENTION

The present application discloses a communication terminal equipment for wireless communication between communication terminal equipment operating according to a cordless communication standard such as DECT or mobile radio telephone standard such as GSM or CDMA. (See page 1, lines 4-9). In particular, the present application discloses a communication terminal equipment that reduces the number of unsuccessful call attempts in situations where a communication terminal equipment is operated as subscriber equipment in a plurality of communication systems in which the equipment can often be reached by a different network addresses (e.g., telephone numbers). (See, page 2, lines 3-16).

The figure accompanying the present specification illustrates a communication terminal equipment KE, which includes a control means CPU, a program memory PMK, a memory IDKE for a communication terminal equipment identifier and a memory NAM for network addresses under which the equipment KE may be reached and also contains a control network address. (See, page 6, lines 4-8). Also illustrated in the figure are two communication systems KS1 and KS2 that have base stations BS11, BS12 and BS2 with which the terminal equipment KE may wirelessly communicate. (See, page 6, lines 9-21). Both of the communications systems KS1 and KS2 are also coupled to a communication network KN and can thus, be connected to one another. (See, page 6, lines 21-23).

In operation, when the communication terminal equipment KE is in the transmission/reception area of the transmission/reception base station BS11 of the communication system KS1, for example, a recognition means realized by the control means CPU and program memory PMK recognizes the communication system KS1 to which the transmission/reception base station BS11 belongs. (See, page 7, lines 3-12). The control means

CPU communicates a network address by which the equipment KE may be reached via a network interface NIF1 and the communication network KN to a control network address stored in the network address memory NAM. (See, page 7, lines 12-16). When calls are directed to the communication terminal equipment KE via the other communication system KS2, in the present example, an address of a performance feature controller LMSC of the communication network KN can be provided as a control network address in order to activate the future of call redirection for these calls. (See, page 7, lines 17-21). Another example, the address of a performance feature controller LS2 of the communications system KS1 may be provided as the control network address in order to activate the feature of call redirection for calls directed to the equipment KE via the communication system KS2 when the terminal equipment KE is connected to a base station of communication system KS1. (See, page 7, lines 22-26).

The presently disclosed system thus makes possible for a communication terminal equipment to have calls directed thereto to be rerouted to a pre-defined telephone address or network address under which the terminal equipment could currently be reached even when a call is directed to a communication system by which it can not currently be reached. (See, page 4, lines 1-15).

VI. ISSUE

Are claims 7-12 obvious under 35 U.S.C. §103(a) in light of U.S. Patent No. 5,754,542 to *Ault* in view of U.S. Patent No. 5,995,828 to *Nishida*?

VII. GROUPING OF CLAIMS

Claims 7-12 stand or fall together.

VII. ARGUMENT

CLAIMS 7-12

1. Legal standards.

35 U.S.C. §103(a) states that:

> A patent may not be obtained.... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time

> the invention was mad to a person having ordinary skill in the art t which said subject matter pertains.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated that the foundation facts for a *prima facie* case of obviousness are:

> (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness....Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, USPQ2d 1596 (Fed. Cir. 1988). Second there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ, 580 (CCPA 1974).

In the present case, the Patent Office has failed to establish a *prima facie* case of obviousness because the cited references fail to teach or suggest every element of the claimed invention, and there is no teaching or suggestion within the references cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested.

2. The references *Ault* and *Nishida*, either combined or taken separately, fail to teach or suggest every element of claims 7-12 and the references or the general knowledge in the art fail to suggest motivation to combine these references.

Concerning independent claim 7, the Appellant submits that all of the elements of this claim are not taught or suggested by *Ault* and *Nishida*, either combined or taken separately, and further that the teachings of these references and/or the knowledge in the art would not motivation one of ordinary skill in the art to combine these references to achieve the claimed features. In rejecting this claim, the Examiner asserted in the final Office Action that *Ault* discloses the elements of this claim except for the element "wherein the network address communicated to the control network address stored in the memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot currently be reached." The Examiner then asserted that *Nishida* teaches this element that was missing from *Ault* where a communication system moves from one network to another, wherein network addresses are used for identifying each network and that it would have been obvious to one of ordinary skill in the art to provide the teachings of *Nishida* with *Ault* in order to enable a user to establish communication between different networks. These assertions are not tenable for the following reasons.

First, *Ault* does not teach or suggest a "control means configured to allocate a network address to the recognized communication system under which the communication terminal apparatus can currently be reached and to communicate the network address via the selected base station to a control network address stored in a memory of the communication terminal apparatus" as featured in claim 7. In rejecting this element, the Examiner cited column 3, lines 64-67 and column 4, lines 1-15 of *Ault* in support of the rejection. This referenced section teaches a system determination processor 8 of a multi-mode subscribe station (MMSS) that selects the communications system to acquire based on information from a CDMA channel table 10 and a system preferences table 12 in accordance with user preferences stored in a nonvolatile memory 14. System determination is influenced by a set of expressed user preferences. *Ault* gives examples of what the user preferences include, such as using one selected serving system or using one mode only such as CDMA. (See Exhibit B, col. 4, lines 10-15).

The system determination through the use of user preferences stored in the nonvolatile memory 14 of *Ault* is not comparable with the claim features quoted above. In particular, the referenced teaching of *Ault* does not teach or suggest a control means that allocates a "network

address" and a "control network address" as featured in claim 7[1]. The system preferences of *Ault* are simply a set of expressed user preferences stored in a memory. These system preferences merely refer to communications attributes that a particular user would select and not allocation of network addresses or control network addresses.

During a personal interview with the Examiner on December 2, 2003, the Examiner asserted that the mode selections disclosed by Ault in column 4, lines 8-18, would be equivalent to an allocation of network addresses. In particular, the Examiner alleged that the term "address" is broad and could be equated by the Patent Office to the "modes" taught by *Ault*, and referred to technical dictionaries. Nonetheless, this allegation is specious. The setting of a CDMA or analog mode preference as definitively taught by *Ault* is simply not the same thing as the allocation of a network address. Deciding if a particular system is used or a particular type of system (i.e., CDMA or analog) will never achieve the allocation of a network address. This is akin to saying that someone by merely selecting that their wireless phone will use a wireless network (e.g., Verizon) with CDMA would automatically be allocated with a network address (e.g., a telephone number). This is simply a stretch far beyond the actual teachings of the reference and defies common knowledge in the art.

Moreover, based on the teachings of *Ault* referenced by the Examiner, the Appellant submits that this teaching simply does not disclose or suggest that the processor 8 allocates a

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[1]The Appellant notes that the Examiner asserted in the final Office Action that the Appellants, in arguing this point in the response of April 3, 2003, had relied on features not recited in the rejected claims. In particular, the Examiner asserted that the claimed "network address" and "control network address" are not recited in the rejected claims. This is simply false. In particular, claim 7 recites a "control means configured to allocate a network address" and "to communicate the network address via the selected base station to a control network address." Thus, the features are indeed found in claim 7. Further, the point of the Appellant's argument in the response of April 3, 2003, was that the taught user preferences stored in a non-*Ault* memory as disclosed by *Ault* et al. are simply not the same thing as these claimed features, even though the Office Action tries to correlate this teaching of *Ault* et al. to these features in claim 7.

network address (e.g., a telephone number) to the recognized communication system (i.e., the CDMA system or the analog system). This is because the system of *Ault* et al. is a cellular system (see column, lines 15-17) and it is well known that in cellular systems, the base stations know from other information received from MMSS's where the MMSS's can be reached. Thus, it would not be necessary for the MMSS of *Ault* to allocate a network address (e.g., a telephone number).

Additionally, the Examiner has not specifically pointed out in the rejection of claim 7 how either *Ault* or *Nishida* teach or suggest a "control network address" as featured in the claim. As a matter of clarification, the term "control network address" is a type of neologism, which is used to express that there is another network address (e.g., another telephone number) that has a control functionality communicating the network address or control information via the selected base station to another network address with a control functionality to assist in handling a call intended for the communication terminal apparatus, but directed to a communication system via which the communication terminal apparatus cannot currently be reached. This feature simply is not taught or suggested by the cited references. In particular, the sections of *Nishida* referenced in the final Office Action (i.e., col. 4, ll. 60-65), contrary to the assertions therein, simply do not teach or suggest the features they are alleged to teach.

Additionally, *Nishida* does not make up for the deficiencies of *Ault* in that the missing elements of *Ault* (i.e., network address or control network address) are not taught or suggested by *Nishida*. In particular, *Nishida* describes with respect to Figures 1 and 3, how a handy phone 116 responds to a public incoming call arriving at the public base station 108 when the handy phone 116 moves and stays in the private communication zone 117 with private branch exchange 100. In order to handle this incoming call, the control section 112 of the public base station 108 responds to the incoming call with the information designating a first network address of the handy phone 116 by transmitting the information via a system-to-system interface 113, 107 to a control 106 of the private branch exchange 100 for conversion of the network address, thereby allowing the handy phone 116 to receive the incoming call even when the phone 116 is in the private communication zone 117. Thus, a control network address, is not disclosed or even necessary because the public base station 108 and the private branch exchange 100 are directly linked via the system-to-system interfaces 113, 107. The Examiner's statement in the final

Office Action responding to the Appellant's arguments in the response of April 3, 2003, that claim 7 does not mention that the apparatus should not have an interface[2] misses the point of the above argument. Rather, the Appellant is merely pointing out that claim 7 features a control network address, whereas the system-to-system interfaces of *Nishida* render the existence of a control network address unnecessary. Thus, *a priori*, *Nishida* does not teach or suggest a control network address.

Furthermore, in the system of *Nishida* the base stations communicate with each other without the involvement of the handy phone 116. In contrast, claim 7 features communicating "the network address via the selected base station to a control network address stored in a memory of the communication terminal apparatus." Thus, since *Nishida* does not teach or suggest communication between base stations with the involvement of the handy phone 116 (i.e., the equivalent of the claimed communication terminal apparatus), *Nishida* further cannot teach or suggest all of the elements of claim 7. Additionally, combining *Nishida* with *Ault* et al. still fails to teach or suggest this element.

Moreover, communication between base stations in *Nishida* occurs when an incoming call arrives at the public base station 108. In contrast, communication in the system of claim 7 occurs before an incoming call arrives at one of the base stations at a point when the terminal recognizes the corresponding base station of the communication system the terminal has entered. Thus, *Nishida* further cannot teach or suggest the elements for which it is relied upon.

Additionally, the Examiner in responded in the final Office Action to the Appellant's previous argument that *Ault*'s memory in not used for assisting in handling a call intended for the communication terminal apparatus, asserts that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references, but rather that the test is what the combined teachings of the references would have suggested to one of ordinary skill in the art. Although this is a correct statement of case law, (i.e., *In re Keller*) this principle of law is not necessarily a carte blanche prescription permitting

[2] See Exhibit A, page 6, last paragraph.

the U.S.P.T.O. to simply cobble together references that one of ordinary skill in the art simply would not be motivated to combine. More importantly, this response misses the point of the present argument, which is actually pointing out that the teachings of *Ault* et al. simply do not show all of the claimed features and the U.S.P.T.O. is not relieved of the duty to indeed show that all of the elements are met by the combined teachings of the references. The Appellant maintains that this argument is valid in pointing out the omission of teaching by the references that meet all of the claimed elements.

With respect to independent claim 8, the Appellant submits that the cited prior art does not teach all of the claimed elements of this claim for the reasons presented above with respect to claim 7. Additionally, the cited prior art does not teach or suggest a control network address stored in the memory of the communication apparatus that influences an activation/deactivation condition related to another communication system not having a selected base station upon a call being made to a communication terminal apparatus but directed to the communication system not having the selected base station.

Accordingly, in light of the foregoing, independent claims 7 and 8 are not obvious in light of the teachings of *Ault* in view of *Nishida.* Specifically, the Appellant submits that the Patent Office has failed to establish a *prima facie* case of obviousness because the cited references fail to teach or suggest every element of the claims and because the cited references fail to teach or suggest within the references themselves or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested. Furthermore, claims 9 through 12, which depend from claim 8, are allowable over the cited references for the same reasons presented above. Accordingly, the Appellants ask that this rejection be reversed.

CONCLUSION

U.S. Patent No. 5,754,542 to *Ault et al.* and U.S. Patent No. 5,995,828 to *Nishida* do not disclose every element of claims 7-12. Further, motivation is lacking to suggest combination of these references to make obvious the elements of claims 7-12. For these reasons, the Appellant respectfully submits that the rejections of claims 7-12 are an error in law and in fact and should, therefore, be reversed by this board.

Respectfully submitted,

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APPENDIX

Claim 7. A dual-mode communication terminal apparatus for wireless communication with a selected base station of one of at least two different communication systems, the communication terminal apparatus being logged on as ready to receive from the selected base station, the communication terminal apparatus comprising:

recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station; and

control means configured to allocate a network address to the recognized communication system under which the communication terminal apparatus can currently be reached and to communicate the network address via the selected base station to a control network address stored in a memory of the communication terminal apparatus;

wherein the network address communicated to the control network address stored in the memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot currently be reached.

Claim 8. A dual-mode communication terminal apparatus for wireless communication with a selected base station of one of at least two different communication systems, the communication terminal apparatus being logged on as ready to receive from the selected base station, the communication terminal apparatus comprising:

recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station; and

control means for allocating a network address to the recognized communication system under which the communication terminal apparatus can currently be reached and communicating control information via the selected base station to a control network address stored in a memory of the communication apparatus for influencing an activation/deactivation condition related to another communication system not having the selected base station upon a call being made to the communication terminal apparatus but directed to the communication system not having the selected base station.

Claim 9. The communication terminal apparatus of claim 8, wherein the control information activates a call redirection relating to a subscriber address under which the communication terminal apparatus can be reached via another communication system not having the selected base station, given corresponding readiness to receive the another communication system by the communication terminal apparatus.

Claim 10. The communication terminal apparatus of claim 8, wherein the control means communicates a network address under which the communication terminal apparatus can be currently reached.

Claim 11. The communication terminal apparatus of claim 8, wherein the memory stores a control network address of a mobility server.

Claim 12. The communication terminal apparatus of claim 8, wherein the memory stores a plurality of control network addresses of a plurality of communication systems, and the communication terminal apparatus further comprising:

selection means for selecting at least one control network address of another communication system not having the selected base station.

SUPPLEMENTAL APPENDIX

Exhibit 1: Copy of Final Office Action of July 14, 2003.

Exhibit 2: Copy of U.S. Patent No. 5,754,542 *Ault et al.*

Exhibit 3: Copy of U.S. Patent No. 5,995,828 *Nishida*